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UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Bjarke de Jager Gottfredsen }
Application No. 09/674,714 }
Filed: December 19, 2000 }
For: Mouse Pad Comprising a Card }
Read/Write Device }

Group Art Unit: 2876

Examiner: Jamara A. Franklin

Attorney Ref. No.: 105.01

OFFICIAL***Petition for Entry of Amendment Pursuant to Rule 1.127***

Commissioner of Patents
PO Box 1450
Alexandria, Virginia 22313

Dear Sir or Madam:

The applicant herewith petitions the Commissioner of Patents to allow entry of after-final amendments pursuant to Rules 1.116 and 1.127. As explained below, the proposed amendments should be entered because they place the claims in "better form for consideration on appeal," by removing the examiner's 35 U.S.C. § 112 rejection.

Background

The present invention covers a read/write device integrated with a mouse pad. It was invented in 1997, and claims priority from a Danish application filed in May, 1998. *See Filing Receipt; Rule 1.131 Decl. of Bjarke de Jager Gottfredsen.* The applicant has obtained corresponding patents in Australia (14834/99) and Europe (EP 1 076 879 B1).

The examiner in this case has issued a number of art-based rejections based on various patents. On November 5, 2003, the examiner issued a rejection based on the Patret patent document (PCT WO 95/24008). In so doing, the examiner found that Patret's "housing" was the same as a "mouse pad," because the examiner defined "mouse pad" to include "any flat surface on which a mouse may operate." 11/5/03 Office Action at 4.

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In response, the applicant's counsel had discussions with the examiner about defining "mouse pad" in the claims, so as to exclude Patret's housing from the scope of the claims. During these discussions, the applicant proposed including a conventional definition of "mouse pad" into the claims. The examiner indicated that the claims would be allowable if so amended. *See* 12/16/03 Office Action Response at 4 (recounting conversation).

Therefore, the applicant amended the claims to include the following definition of "mouse pad": "a relatively small pad with a substantially planar running surface." *See* 12/16/03 Office Action Response at 5 - 11. The applicant made the amendments conditional on allowance, since the examiner had previously changed her mind about allowing the patent, and the applicant did not want to unnecessarily amend the claims. *See* 12/16/03 Office Action Response at 5 ("[t]hese amendments should only be entered if they are both necessary and sufficient for allowance of the claims").

In response, the examiner entered the amendments, and issued a final rejection. *See* 4/6/04 Office Action. The examiner also found that the amendments created a new problem, namely a § 112 defect, since "relatively small" is indefinite. *See* 4/6/04 Office Action at 2.

The applicant then filed an after-final amendment on May 28, 2004. *See* 5/28/04 After Final Amendments to Place Claims in Better Form for Consideration on Appeal. The purpose of these amendments was to rescind the December 16, 2003 amendments, since the examiner had found that those amendments created a § 112 defect. The applicants believe that the May 28, 2004 amendments put the application in better form for consideration on appeal, since they remove the § 112 objection. A copy of these proposed amendments is attached as Exhibit A hereto.

After filing the "unamendments" on May 28, 2004, the applicant filed a notice of appeal on June 28, 2004. *See* 6/28/2004 Notice of Appeal. The appeal is currently pending.

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and the applicant hopes that present petition can be decided before preparation of the opening brief.

Next, on July 9, 2004, the examiner issued an advisory action refusing entry of the after-final amendments. The present petition challenges this decision.

The Proposed Amendments Do Place the Application in Better Form For Consideration on Appeal and Should Have Been Entered

Rule 1.116(b) allows entry of after-final amendments when they present "rejected claims in better form for consideration on appeal." In this case, there can be no doubt that the proposed amendments place the rejected claims (claims 1 - 32) in better form for consideration on appeal, since they remove a ground for rejection, namely the § 112 rejection that was prompted by the December 16, 2003 amendments. With the proposed amendments entered, the applicant and the PTO can concentrate on the art-based rejections during the appellate process.

The proposed amendments place the claims in their previous form, before the inclusion of the phrase "relatively small," which the examiner found objectionable. They do not introduce new matter, but with one exception¹ they simply return the claims to the form they were in before the amendments of December 16, 2003.

The examiner has not provided a cogent reason for the failure to enter the amendments. The examiner cannot deny that the amendments would remove the § 112 rejection, nor can the examiner claim that the amendments introduce new matter. Indeed, the only explanation offered by the examiner for her failure to allow the May 28, 2004 amendments is the claim that the December 16, 2003 amendments were properly entered, despite the applicant's request that they only be entered if they were necessary

¹ The applicant does not seek to rescind the previous amendment changing "connected" to "coupled" in many of the claims.

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to put the claims in condition for allowance.

But whether or not the December 16, 2003 "conditional" amendments were properly entered, there can be no doubt that the May 28, 2004 amendments should have been entered, since they put the application in better form for appeal by removing the § 112 rejection. Therefore, it was abuse of discretion for the examiner to refuse entry of the May 28, 2004 amendments, and they should now be entered.

Date: July 16, 2004

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DANIEL MAGUIRE

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PTO/SB/21 (02-04)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	0674,714	
	Filing Date	12/19/2000	
	First Named Inventor	Bjarke de Jager Gottfredsen	
	Art Unit	2876	
	Examiner Name	Jamara Franklin	
Total Number of Pages in This Submission	13	Attorney Docket Number	105.01

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance communication to Technology Center (TC)
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input checked="" type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Change of Correspondence Address	<input type="checkbox"/> Other Enclosure(s) (please identify below):
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<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Response to Missing Parts/Incomplete Application	Remarks	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Daniel P. Maguire
Signature	<i>Daniel P. Maguire</i>
Date	7/16/04

CERTIFICATE OF TRANSMISSION/MAILING	
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.	
Typed or printed name	Daniel P. Maguire
Signature	<i>Daniel P. Maguire</i>
Date	7/16/04

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/17 (10-03)

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FEE TRANSMITTAL
for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27TOTAL AMOUNT OF PAYMENT (\$) **130****Complete if Known**

Application Number	091674,714
Filing Date	12/19/2000
First Named Inventor	Bjarke De Jager Goffredsen
Examiner Name	Tamara Franklin
Art Unit	2876
Attorney Docket No.	105.01

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:Deposit
Account
Number
Deposit
Account
Name**502321****Daniel Maguire**

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 180	2005 80	Provisional filing fee	
SUBTOTAL (1)			(\$) —

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	-20** =	X	
Multiple Dependent	-3** =	X	

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent
SUBTOTAL (2)		

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	2053 130	Non-English specification	
1812 2,520	2812 2,520	For filing a request for ex parte reexamination	
1804 920*	2804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	2805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 185	Notice of Appeal	
1402 330	2402 185	Filing a brief in support of an appeal	
1403 290	2403 145	Request for oral hearing	
1451 1,510	2451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1503 640	2503 320	Plant issue fee	
1460 130	2460 130	Petitions to the Commissioner	130
1807 50	2807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	2806 180	Submission of Information Disclosure Stmt	
8021 40	28021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	2802 900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) **130****SUBMITTED BY**

Name (Print/Type)	Daniel P. Maguire	Registration No. (Attorney/Agent)	41,506	Telephone	530 750 3661
Signature	Daniel P. Maguire	Date	7/16/04		

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